

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY HIGTON, ROGER GLYDE
AND ROBERT A. WILKINSON

Appeal No. 2001-2071
Application 09/285,921

ON BRIEF

Before OWENS, WALTZ and POTEATE, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-14, which are all of the claims in the application.

THE INVENTION

The appellants claim an oleaginous concentrate and a process for producing such a concentrate. Claim 1, directed toward the process, is illustrative:

1. A process for preparing an oleaginous concentrate for a lubricating oil composition comprising blending at elevated temperature additive components (A) and (B) in the presence of additive component (C), wherein (A) is at least one high molecular weight ashless dispersant comprising an oil-soluble

polymeric hydrocarbon backbone of number average molecular weight of 1,500 or greater having functional groups; (B) is at least one oil-soluble metal detergent:[sic]; and (C) is at least one oil-soluble metal salt of a phosphorus- and/or sulphur-containing acid, wherein the metal of the salt is an alkali metal, an alkaline earth metal, zinc, aluminum, lead, tin, molybdenum, manganese, nickel or copper.

THE REFERENCE

Song et al. (Song)	5,200,103	Apr. 6, 1993
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THE REJECTION

Claims 1-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Song.

OPINION

We affirm the aforementioned rejection.

The appellants state that the claims stand or fall in two groups: 1) claims 1-3 and 5-14, and 2) claim 4 (brief, page 2). We therefore limit our discussion to claim 4 and one claim in the other group, i.e., claim 1. See *In re Ochiai*, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192(c)(7) (1997).

Rejection of claim 1

Song discloses a process for preparing an oleaginous concentrate for a lubricating oil composition (col. 24, lines 3-6), comprising blending, at a temperature which can be elevated

(col. 24, lines 1-3), a high molecular weight ashless dispersant comprising an oil-soluble polymeric hydrocarbon backbone which has functional groups and most preferably has a number average molecular weight of about 1,500 to about 5,000 (abstract; col. 3, lines 61-67; col. 25, lines 6-10),¹ with one or more conventional additives (col. 36, lines 1-25). The conventional additives include an oil soluble metal-containing detergent (col. 26, lines 19-24) and a dihydrocarbyl dithiophosphate zinc salt anti-wear agent/antioxidant (col. 30, lines 55-60).²

The appellants argue that nothing in Song would have motivated one of ordinary skill in the art to blend Song's ashless dispersant and oil-soluble metal-containing detergent in the presence of the zinc dihydrocarbyl dithiophosphate anti-wear agent/antioxidant (brief, page 3). This argument is not persuasive because Song's teaching that his ashless dispersant can be combined in a concentrate with one or more of the listed conventional additives would have fairly suggested, to one of ordinary skill in the art, blending the ashless dispersant with

¹ The appellants state that their ashless dispersants include those of Song (specification, page 7, lines 5-8; brief, page 3).

² Song's zinc dihydrocarbyl dithiophosphate is among the appellants' oil-soluble metal salts of a phosphorous-containing acid (component (C) in the appellants' claim 1).

any or all of the other additives simultaneously or in any order. See *In re Burhans*, 154 F.2d 690, 692, 69 USPQ 330, 332 (CCPA 1946).

The appellants argue that Song's teaching that highly basic metal salts are frequently used as detergents and appear to be particularly prone to interaction with the ashless dispersant (col. 26, lines 24-27) would have discouraged one of ordinary skill in the art from forming a concentrate containing these two components (brief, page 4). Song's teaching, however, that highly basic alkaline earth metal sulfonates are used as detergents in his additive system (col. 26, line 34 - col. 27, line 17) would have indicated to one of ordinary skill in the art that any interaction between the highly basic detergent and the ashless dispersant does not render these two additives unsuitable for use together in Song's concentrate.

The appellants argue that the data in their specification (page 24, table 1) show that concentrates formed by blending the appellants' components (A) and (B) in the presence of (C) have a viscosity which is lower by a factor of two to five compared to concentrates formed by blending identical components (A) and (B)

in the absence of (C) (brief, page 3). As discussed above, Song would have fairly suggested, to one of ordinary skill in the art, combining all three of the appellants' components (A), (B) and (C). Hence, the proper comparison would be between blending components (A) and (B) in the presence of (C) versus blending (A) and (B) in the absence of (C) and then blending (C) into the mixture of (A) and (B). The appellants have not provided this comparison, let alone established that it shows unexpected results.

For the above reasons we conclude that the process recited in the appellants' claim 1 would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103.

Rejection of claim 4

The appellants' claim 4, which depends from claim 1, requires that the metal salt is blended with the ashless dispersant before blending with the metal detergent.

The appellants argue that "[c]learly, there is nothing in the Song et al. patent that would suggest the preblending of components (A) and (C) prior to introduction of component (B)" (brief, page 5). As discussed above regarding the rejection of claim 1, however, it would have been *prima facie* obvious to one

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of ordinary skill in the art to mix Song's additives in any order. For the reason given above regarding the rejection of claim 1, the evidence relied upon by the appellants is not effective for rebutting this *prima facie* case of obviousness.

Accordingly, we conclude that the process recited in the appellants' claim 4 would have been obvious to one of ordinary skill in the art over Song.

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DECISION

The rejection of claims 1-14 under 35 U.S.C. § 103 over Song
is affirmed.

AFFIRMED

TERRY J. OWENS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
THOMAS A. WALTZ)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
LINDA R. POTEATE)	
Administrative Patent Judge)	

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PAUL D. GREELEY, ESQ.
OHLANDT, GREELEY, RUGGIERO
& PERLE, L.L.P.
ONE LANDMARK SQUARE, 9TH FLOOR
STAMFORD, CT 06901-2682

TJO:caw